



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Franciscus, Theodorus, Cornelis GEERTS

Appl. No. 09/767,496

Filed: January 24, 2001

For: **A VEHICLE FOR DETERMINING THE
CLIMATE**

Art Unit: 2632

Examiner: LA, ANH V

Atty. Docket: 8553/201

DECLARATION IN SUPPORT OF PETITION TO REVIVE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

- 1) I, Frans J.A. de Groen, am the representative of the Assignee of the above-referenced application and have been responsible for the prosecution of the application since August 2002;
- 2) Our previous U.S. patent counsel, Mr. Penrose Albright, died late last year;
- 3) We were informed of Mr. Albright's death by letter from his son. This letter further informed us that the entire law firm would, because of Mr. Albright's death, be dissolved immediately;
- 4) Review of the patent applications being handled by Mr. Albright reveals that Mr. Albright did not respond to an outstanding Office Action issued in the above-referenced application and that this application went abandoned; and
- 5) the entire delay in filing the required reply to the Office Action from the due date for the required reply until the filing of the grantable petition under 37 CFR 1.137(b) filed herewith was unintentional.

Respectfully submitted,

F.J.A. de Groen

Dutch Patent Attorney

Date: March 3, 2008

OCTROOIBUREAU VAN DER LELY NV

Weverskade 10 • 3155 PD Maasland • Nederland

Mason, Mason & Albright
Attn: Mr. P.L. Albright
P.O. Box 2246
ARLINGTON, VIRGINIA 22202
U.S.A.

TELEFAX (1 page)
CONFIRMATION BY MAIL

5 June 2003

Re: U.S. Patent Application Serial No. 09/767,496
Applicant: Lely Enterprises AG
Your ref: 8553/201
Our ref: 4190/PCT/US/FG/NHw

Dear Mr. Albright,

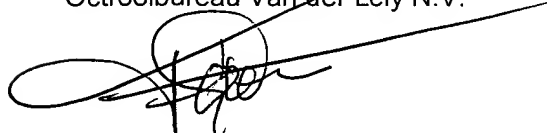
Reference is made to your letter of 9 April, 2003 in respect of the above-mentioned patent application.

Please be informed herewith that you may submit a request for continued examination together with a further amendment, setting forth the arguments against the obviousness rejections under 35 USC § 103, as put forward in your letter of 9 April, 2003.

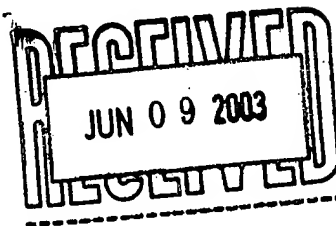
Please confirm receipt of this letter via facsimile.

Yours sincerely,

Octrooibureau Van der Lely N.V.



F.J.A. de Groen



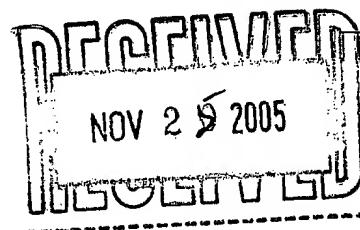
OCTROOIBUREAU VAN DER LELY NV

Weverskade 110 • 3147 PA Maassluis • Nederland

Mason, Mason & Albright
Attn: Mr. J.H. Greger, Mr. P.L. Albright
2306 South Eads Street
P.O. Box 2246
ARLINGTON, VIRGINIA 22202
United States of America

TELEFAX (1 page)

November 24, 2005



Re: US Patent Application No. : 09/767,496
Applicant : LELY ENTERPRISES AG
Your ref. : 8553/201
Our ref. : D4190/PCT/US/FG/rm
Status of Patent

Dear Mr. Greger and Mr. Albright,

Reference is made to our letter dated October 7, 2003.

Please inform us what the status of the above mentioned US Patent Application is.

Thank you in advance.

Please confirm the receipt of this letter.

Octrooibureau Van der Lely N.V.

F.J.A. de Groen

MASON, MASON & ALBRIGHT

ATTORNEYS AT LAW

2306 SOUTH EADS STREET

P.O. BOX 2246

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C.A. MASON (1866 - 1943)
JOHN M. MASON (1893 - 1963)
PENROSE LUCAS ALBRIGHT
JEFFREY H. GREGER

PATENT AGENT,
ERIC S. ALBRIGHT

OF COUNSEL
WILLIAM B. MASON

INTELLECTUAL PROPERTY LAW
PATENT, TRADEMARK, COPYRIGHT
ASSOCIATED TECHNICAL MATTERS

December 2, 2005

VIA FACSIMILE

Mr. F.J.A. de Groen
Octrooibureau van der Lely N.V.
Weverskade 110
NL-3147 PA Maassluis
HOLLAND

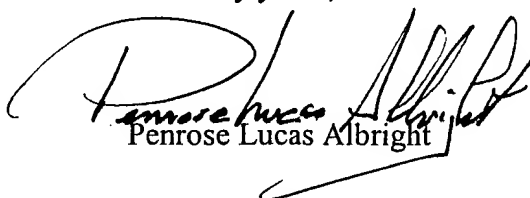
Re: U.S. Patent Application Serial No. 09;/767,496
A VEHICLE FOR DETERMINING THE CLIMATE
Your Ref: D4190/PCT/US/FG/rm
Our Ref: 8553/201

Dear Mr. de Groen:

In response to your telefax of November 24, 2005, it is my intent to file a Petition for Revival for the above-identified Application. However, it will not be a "timely" Petition inasmuch as the deadline for doing so was before I became aware that we had a number of Applications wherein a Petition for Revival was necessary. Nevertheless, if my understanding of the cause of the abandonment is correct, and if my recollection of the law applicable to untimely Petitions is also correct, we should be able to obtain a revival of the Application, in which case we will file a Request for Continued Examination together with an appropriate Amendment. But I need to investigate the cause more thoroughly and update the present status of the applicable law first.

We will, in any event, keep you advised.

Sincerely yours,


Penrose Lucas Albright

PLA:wp

OCTROOIBUREAU VAN DER LELY NV

Weverskade 110 • 3147 PA Maassluis • Nederland

Mason, Mason & Albright
Attn: Mr P.L. Albright
P.O. Box 2246
ARLINGTON, VIRGINIA 22202
U.S.A.

TELEFAX (1 page)
CONFIRMATION BY MAIL

March 8, 2007

Re: U.S. Patent Application Serial No.: **09/767,496**
Applicant : LELY ENTERPRISES AG
Your ref. : 8553/201
Our ref. : D4190/PCT/US/FG/lh

Dear Mr Albright,

Reference is made to your letter of December 2, 2005 concerning the above-mentioned US Patent Application. You informed us that you had the intention to file a Petition for Revival.

Since we have not received any information from you, we recently checked the Bibliographic Data of the USPTO and we found that the status of the application number 09/767,496 is "abandoned – failure to respond to an Office Action".

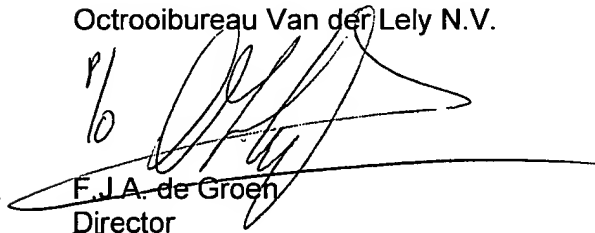
We appreciate it if you could clarify this matter.

Please take good notice that we do not feel obliged to pay any costs due to failures on your side.

We look forward to receiving your earliest reply.

Sincerely yours,

Octrooibureau Van der Lely N.V.


F.J.A. de Groen
Director

Tel. +31(0)10-59 96 333
Fax +31(0)10-59 96 384

IBAN: NL80 ABNA 0438 8859 02
BIC: ABNANL2A

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. 17

HOWREY LLP - DC
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH VA 22042-2924

COPY MAILED

SEP 15 2008

OFFICE OF PETITIONS

In re Application of :
Franciscus Theodorus Cornelis Geerts :
Application No. 09/767,496 : DECISION ON PETITION
Filed: January 24, 2001 :
Attorney Docket No. 04132.0096.PCUS00 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 4, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed April 22, 2003, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on June 23, 2003. See MPEP 1215.04.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

REC'D HOWREY NT 09/17/08

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (almost 5 years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on June 23, 2008. That party, in turn must explain what effort(s) was made

to further reply to the outstanding Office action and, further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). The record indicates that Mr. Penrose Albright was responsible for prosecution of the application when the reply necessary to avoid abandonment was due. Therefore, petitioner must provide a statement from Mason, Mason & Albright explaining why action was not timely taken to prevent the application from becoming abandoned.

Petitioner is advised to send a letter (accompanied by a copy of this decision) to Mason, Mason & Albright at 2306 South Eads Street Alexandria, VA 22202, by certified or registered mail (return receipt requested) indicating that the U.S. Patent and Trademark Office (USPTO) is requesting assistance in ascertaining the cause of abandonment of the above-identified application, and that the USPTO is requesting that Mason, Mason & Albright provide within a specified period (e.g., one month) a statement setting forth why appropriate action was not timely taken to prevent the application from becoming abandoned. Petitioner is advised that, in the event that Mason, Mason & Albright will not provide such a statement, petitioner should submit a copy of such letter and a copy of the return receipt.

Copies of any and all correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), Mason, Mason & Albright and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons then at the law firm of Mason, Mason & Albright, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent

abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over 5 years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons then at Mason, Mason & Albright and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival. Petitioner asserts that a correspondence from the assignee dated June 5, 2003 requesting prior counsel to file a Request for Continued Examination instead of an Appeal Brief, but no copy was provided with the petition. Petition also states that there are status request from the assignee to the prior counsel dated November 24, 2005 and again on March 8, 2007. A copy of these status requests must be provided for consideration of this petition. Further the petitioner and /or assignee must explain the delay between the periods of December 2005 and the filing of this petition.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

- (A) the date that the applicant first became aware of the abandonment of the application; and
- (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S. District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

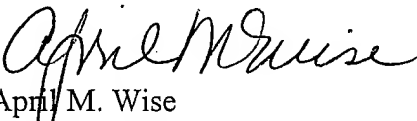
By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-1642.


April M. Wise
Petitions Examiner
Office of Petitions